

REMARKS

Claims 1-6 and 8-15 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added. Additionally, no new issues have been raised by the present submission which would require additional search and/or consideration on the part of the Examiner. In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for an appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 and 8-15 under 35 U.S.C. § 103(a) as being obvious over Ito '084 in view of JP '136 or Adin. Applicants respectfully traverse this rejection.

Applicants herein incorporate all previously submitted arguments of record. Each of these arguments is preserved should an appeal become necessary.

Additionally, Applicants take this opportunity to address the comments of the Examiner as set forth in the outstanding Office Action. In particular, the Examiner has outlined three reasons for asserting that the declarative evidence and the arguments of record are unpersuasive. Applicants respectfully disagree with the Examiner.

1. Statement of unexpected results is allegedly based on Counsel's assertion.

The Examiner has asserted that the arguments concerning unexpected results are based upon assertions in the body of the argument and that in fact the declaration is to be given little probative value. The Examiner has asserted that Mr. Yamaguchi, although explaining that he is the inventor of the present application, does not provide a statement that he considers himself to be one of skill in the art.

Applicants respectfully submit that it is improper for the Examiner to assert that Mr. Yamaguchi, one the present inventors, is not one of skill in the art. However, in order to address this concern of the Examiner, Applicants have prepared a modified Declaration pursuant to 37 C.F.R. § 1.132. In this modified Declaration Mr. Yamaguchi fully explains that he is one of skill in the art and additionally explains that the results presented in the Declaration are unexpected. Accordingly, this issue raised by the Examiner is moot.

2. The Examiner alleges that the results are expected.

The Examiner asserts that the results, including the results concerning Dmin (after leaving), would have been expected based upon the secondary references of JP '136 or Adin '260. The Examiner has made this argument in two stages.

First, the Examiner has asserted that there is no significant difference between samples A-3 and A-4. Although it maybe true that both samples have the same Dmin and a similar Dmax, there is certainly an increase in sensitivity and an improved Dmin (after leaving). For instance, the decrease in Dmin after leaving of 0.06 (comparison between A-3 and A-4, or

between A-9 and A-10) or of 0.05 (comparison between A-5 and A-6, or between A-7 and A-8) is significant. The Examiner has not provided evidence to the contrary.

Second, the Examiner asserts that the improvement in sensitivity and in Dmin (after leaving) would have been expected by the use of the compound of JP '136 or Adin '260. Although both references discuss improvements in sensitivity, neither JP '136 nor Adin '260 discusses the alteration of Dmin (after leaving).

Indeed, both JP '136 and Adin '260 are silent concerning Dmin after leaving. The Examiner seems to confuse Dmin before leaving with Dmin after leaving. As the Examiner points out in page 6, lines 2-3 in the official action, Adin only states that his silver halide emulsion does not increase fog (Dmin) beyond acceptable limits. Adin does state that his silver halide emulsion reduces fog. The term "fog" in Adin is Dmin before leaving. Thus, no one skilled in the art would have readily appreciated that the compounds of JP '136 and Adin '260 are capable of reducing Dmin after leaving.

3. The results are allegedly not commensurate in scope with the claimed invention.

The Examiner points out that the results presented in the Declaration relate to the use of the silver salt of an organic acid containing high silver behenate content and bisphenol reducing agent, which are preferred according to the present invention, in Ito '084, and in the photographic art. In contrast, the scope of the claimed silver salt encompasses the scope of non-preferred silver salts of organic acids and reducing agents.

Regardless of the truth of the above assertion, the legal requirement for comparative evidence is that the closest example according to the prior art is compared with the claimed invention. The comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested. In re Kuderna, 165 USPQ 575 (CCPA 1970). In fact, Applicant is permitted to test compounds which are even more closely related than those of the prior art. Ex parte Humber, 217 USPQ 265 (POBA 1981).

In the present instance, the closest example of Ito '084 was replicated using the material and methods of Ito '084. This has already been explained several times. Then, a comparison with the present invention was made by simple addition of compound 95 of JP '136. No additional changes were made. This is true for each of the comparisons presented in the Yamaguchi Declaration as well as the new Declaration. Legally, once unexpectedly superior results are shown under these circumstances, the *prima facie* of obviousness must fall. Thus, additional experimentation for other aspects of the present invention, which are further removed from that of the comparison, need not be performed.

The Examiner has also asserted that there is no evidence showing that results are derived by the combination of the compound or formula (1) and the second compound or formula (1) and (2) or (3) alone. Applicants disagree. In particular, exemplary compounds, using the prior art as

a guide, have been selected within the scope of the present invention. This should be all that is required.

In summary, Applicants submit that it is evident that the present invention achieves unexpectedly superior results compared to the cited art. Accordingly, any hypothetical *prima facie* case of obviousness, which Applicants disagree on the existence thereof, is therefore moot. The Examiner is thus requested to withdraw this rejection.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1-6 and 7-15 (note that claim 7 has been canceled) under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-20 of U.S. Patent No. 6,764,816 (Ohzeki) in view of Ito '084. Applicants respectfully traverse this rejection.

As shown above, the present invention achieves unexpectedly superior results compared the cited art. Thus, this rejection is overcome for the same reasons. Additionally, Applicants point out that it is not obvious from claims 1-20 of U.S. Patent No. 6,764,816 that the combination of the claimed two types of compounds achieves the synergetic improvements of sensitivity and reduction of Dmin after leaving. Thus, this rejection is improper and should be withdrawn.

In view of the above, Applicants respectfully submit that the present application is in condition for allowance. The Examiner is therefore respectfully requested to withdraw all rejections and allow the currently pending claims.

Application No. 10/046,141
Amendment dated June 29, 2007
After Final Office Action of December 29, 2006

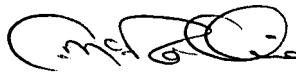
Docket No.: 2870-0177P

If the Examiner has any questions or comments, please contact Craig A. McRobbie,
Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies
to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional
fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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